

Advisory ActionApplication No.
10/046,480Applicant(s)
ShiraiwaExaminer
Mark WallersonArt Unit
2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Mar 31, 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]


- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____
- Claim(s) objected to: _____
- Claim(s) rejected: 63-66 and 68-71
- Claim(s) withdrawn from consideration: _____
8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

 **MARK WALLERSON**
PRIMARY EXAMINER
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Part III DETAILED ACTION

Notice to Applicant(s)

1. This action is responsive to the following communications: amendment filed on **3/31/2003**.

2. This application has been reconsidered. Claims 63-66 and 68-71 are pending.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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4. Claims 63, 64, 65, 66, 68, 69, 70, and 71 are rejected under 35 U.S.C. 102(e) as being anticipated by Haneda (U. S. 6,243,171).

With respect to claims 63, 65, 66, 70, and 71, Haneda discloses an image reproduction control apparatus (figure 1) comprising a storage unit using a detachable memory (column 14, lines 30-32), the detachable memory storing a plurality of reproducible images (column 14, lines 56-65) and a reproduction instruction file (which reads on parameter data or order information) (column 15, lines 53-63 and column 18, lines 33-36), including file names specifying one or more images to be reproduced, the file name in an order (figure 17); a reading section for reading the reproduction instruction file (column 18, lines 55-67); a reproduction control section for controlling reproduction of the images by reading the images to be reproduced (column 15, lines 53-63 and column 20, lines 53-67), and display means allowing a user to display images in order, images to be reproduced with a mark indicating whether the one or more images are to be reproduced (which reads on the order data including a number specifying the images for which extra copies are desired (column 1, line 57 to column 2, line 4; column 3, lines 64-67; column 5, lines 40-57; column 10, lines 35-44; column 16, lines 61-67; column 18, lines 14-54 column 19, lines 4-7; column 20, lines 12-27; column 23, lines 33-37; column 22, lines 62-66; column 32, lines 6-12; and column 5, lines 23-29), and starting the reproduction in accordance with input from a user (the user enters the printing conditions) (column 20, lines 57-67), and performing the reproduction of images to be reproduced after the user confirms that the images specified by the

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reproduction instruction file are to the reproduced (the images are printed after the order data is read) (column 10, lines 35-44 and column 20, lines 45-67).

Haneda also discloses determining whether the instruction file is in the detachable memory (column 21, lines 58-67 and column 22, lines 59-61).

With respect to claim 64, Haneda discloses recording the instruction file in the detachable memory in accordance with user input (column 18, lines 25-36).

With respect to claim 68, Haneda discloses the reproduction instruction file (order file) includes one or more reproduction instructions (size or trimming), and one of the instructions is a print instruction (number of copies) (figure 18).

With respect to claim 69, Haneda discloses the display section is operated in accordance with the attachment of the memory (column 10, lines 3-12).

Response to Arguments

5. Applicant's arguments filed 3/31/2003 have been fully considered but they are not persuasive. Applicant submits that Haneda does not disclose starting the reproduction in accordance with input from a user and performing the reproduction of images to be reproduced after the user confirms that the images specified by the reproduction instruction file are to the reproduced. The Examiner respectfully disagrees.

Haneda discloses connecting a printer to the playback device, wherein by employing the printer, the user is capable of creating photographs of desired images that are being displayed

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(column 10, lines 35-44). Haneda also discloses starting the reproduction in accordance with input from a user (the user enters the printing conditions) (column 20, lines 57-67), and performing the reproduction of images to be reproduced after the user confirms that the images specified by the reproduction instruction file are to be reproduced (the images are printed after the order data is read) (column 10, lines 35-44 and column 20, lines 45-67).

Conclusion

6. All claims are rejected.

7. Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Wallerson whose telephone number is (703) 305-8581.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, DC 20231

or faxed to:

(703) 872-9314 (for formal communications intended for entry)

(for informal or draft communications, such as proposed amendments to be discussed at an interview; please label such communications "PROPOSED" or "DRAFT")

or hand-carried to:

Crystal Park Two
2121 Crystal Drive
Arlington, VA.
Sixth Floor (Receptionist)

MARK WALLERSON
PRIMARY EXAMINER

Mark Wallerson